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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FISH & NEAVE IP GROUP ROPES & GRAY LLP 1251 AVENUE OF THE AMERICAS FL C3 NEW YORK, NY 10020-1105			BOSWELL, CHRISTOPHER J	
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			3676	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/723,911	Applicant(s) LAX ET AL.	
	Examiner Christopher Boswell	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-130 is/are pending in the application.
- 4a) Of the above claim(s) 97-106 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-96 and 107-130 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/18/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 123-130 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication Number 2002/0003095 to Jaeb et al.

Jaeb et al. also disclose a key arrangement (24) for at least one of locking and unlocking a container (10), the container having a receptacle, wherein the receptacle has an open configuration (figure 1) which allows access to an asset and a closed configuration (figure 3) which encloses the asset, and the container having a locking member (18) that is configured to move between an unlocked position in which the receptacle is in the open configuration and a locked position which locks the receptacle in the closed configuration (22), wherein the locking member has at least one magnetically attractable portion (72), the key arrangement having a channel portion (figure 15), wherein the channel portion is configured to receive the container (figure 16), and at least one magnetic arrangement (90), wherein the at least one magnetic arrangement is configured to hold the at least one magnetically attractable portion of the locking member within a magnetic field created by the at least one magnetic arrangement while the container slides through the channel, thereby positioning the locking member in at least one of the locked and unlocked positions (figures 15-17), as in claim 123, wherein the locking member

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has first and second magnetically attractable portions, the key arrangement further comprising first and second magnetic arrangements (90 and 90), wherein the first magnetic arrangement is configured to hold the first magnetically attractable portion of the locking member within a magnetic field created by the first magnetic arrangement (figure 18), and wherein the second magnetic arrangement is configured to hold the second magnetically attractable portion of the locking member within a magnetic field created by the second magnetic arrangement (figure 18), as in claim 124.

Jaeb et al. further disclose the channel portion comprises a first wall portion and a second wall portion forming the channel therebetween (figure 15), wherein the first magnetic arrangement is situated within the first wall portion, and wherein the second magnetic arrangement is situated within the second wall portion (figure 18), as in claim 125, as well as the channel portion comprising a first wall portion and a second wall portion forming the channel therebetween (figure 15), wherein the channel has a first end and a second end, wherein the first magnetic arrangement is situated within the first wall portion at the first end of the channel (figure 18), and wherein the second magnetic arrangement is situated within the second wall portion at the second end of the channel (figure 18), as in claim 126.

The recitation that the entirety of the locking member is internal to the container in the unlocked position has been given little patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is self-contained description of the structure not depending for completeness upon the introductory clause.

Jaeb et al. additionally disclose a method for at least one of locking and unlocking a container (10), the container having a receptacle, wherein the receptacle has an open configuration which allows access to an asset and a closed configuration which encloses the asset, and the container having a locking member (18) that is configured to move between an unlocked position in which the receptacle is in the open configuration and a locked position which locks the receptacle in the closed configuration (22), wherein the locking member has at least one magnetically attractable portion (72), the method provides a key arrangement (24) having a channel portion (figure 15) and at least one magnetic arrangement (90), positioning the container within the channel portion (figure 16), holding the at least one magnetically attractable portion of the locking member within a magnetic field created by the at least one magnetic arrangement (figure 16), and while holding the at least one magnetically attractable portion of the locking member within the magnetic field created by the at least one magnetic arrangement, sliding the container through the channel such that the locking member attains at least one of the locked and unlocked positions (figure 17), as in claim 127, wherein the locking member has first and second magnetically attractable portions (72), wherein the key arrangement has first and second magnetic arrangements (90), and wherein the holding the at least one magnetically attractable portion of the locking member within a magnetic field created by the at least one magnetic arrangement further holds the first magnetically attractable portion of the locking member within a magnetic field created by the first magnetic arrangement (figure 18), and holding the second magnetically attractable portion of the locking member within a magnetic field created by the second magnetic arrangement (figure 18), as in claim 128.

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Jaeb et al. also disclose 129. The method of claim 128, wherein the channel portion comprises a first wall portion and a second wall portion forming the channel therebetween (figure 15), wherein the first magnetic arrangement is situated within the first wall portion, and wherein the second magnetic arrangement is situated within the second wall portion (figure 18), as in claim 129, as well as the channel portion comprises a first wall portion and a second wall portion forming the channel therebetween (figure 15), wherein the channel has a first end and a second end, wherein the first magnetic arrangement is situated within the first wall portion at the first end of the channel, and wherein the second magnetic arrangement is situated within the second wall portion at the second end of the channel (figure 18), as in claim 130.

The recitation that the entirety of the locking member is internal to the container in the unlocked position has been given little patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method and the portion of the claim following the preamble is self-contained description of the method not depending for completeness upon the introductory clause.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-17, 19-26, 29-33, 35-36, 38-63, 65-87, 90-93, 95-96, and 107-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication Number 2002/0003095 to Jaeb et al.

Jaeb et al. disclose a lockable container (10) for securing an asset therein, comprising a first cover (12), a second cover (14) coupled to the first cover, wherein the first and second covers are configured to move between an open position which allows access to the asset, and a closed position which encloses the asset, a locking mate arrangement (50 and 54) operatively coupled to at least one of the first and second covers, and a locking member (18), wherein the locking member is configured to move between an unlocked position in which the first and second covers can move to the open position and a locked position which locks the first and second covers in the closed position (22), and wherein the locking member is internal to the container in the unlocked position (figures 6-7), as well as an actuation member on the distal end of the locking member (figure 10) extends beyond the container when in the unlocked position, as in claim 1. However, Jaeb et al. do not disclose the entirety of the locking member being internal to the container in the unlocked position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the actuation member from the distal end of the locking member, and actuate the locking member by means of the unlocking pin of the key to move the locking member into both the locked and unlocked positions, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Jaeb et al. additionally disclose the locking member engages the locking mate arrangement when the locking member is in the locked position (figures 6-8), as in claim 2, and wherein the locking member is configured to be acted upon by an external key arrangement (24) to selectively position the locking member into one of the locked position and the unlocked position with respect to the locking mate arrangement (figures 16-17), as in claim 3, wherein the first cover is pivotally coupled (16) to the second cover, as in claim 4, as well as the locking mate arrangement being formed as part of the first and second covers (figures 1 and 2), and wherein the locking member is detachably coupled to the second cover (figures 6-8), as in claim 5, wherein the locking mate arrangement has at least one tab (54) formed in the first cover and at least one corresponding tab (50) formed in the second cover, as in claim 6, and the at least one tab formed in the first cover and the at least one corresponding tab formed in the second cover are in an adjacent relationship when the first and second covers are in the closed position (figures 7-8), as in claim 7, wherein at least a portion of the locking member has an I-beam construction (figures 4 and 5) with a recess formed therein, as in claim 8, and the at least one tab formed in the first cover and the at least one corresponding tab formed in the second cover are located in the recess and prevented from separating when the locking member is in the locked position (figure 8), as in claim 9.

Jaeb et al. also disclose the first cover has at least one pair of top closing walls (32) and the second cover has at least one pair of bottom closing walls (38), and wherein the top and bottom pairs of closing walls are disposed so that each of the respective top and bottom closing walls sits behind the other of the respective top and bottom closing walls when the first cover is closed upon the second cover (figures 1-3), thereby forming a double wall so that each of the

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respective top and bottom closing walls substantially overlaps a major portion of the height of the other of the respective top and bottom closing walls, as in claim 10, wherein each of the at least one pair of top closing walls and each of the at least one pair of bottom closing walls extends the entire width of the respective first and second covers (figure 1), as in claim 11, and where each of the at least one pair of top closing walls and each of the at least one pair of bottom closing walls extends substantially the entire width of the respective first and second covers (figures 1), as in claim 12, as well as the first cover has at least one pair of top closing walls (32), wherein the second cover has top and bottom edges (42) that meet a backside of the second cover, and wherein the at least one pair of top closing walls meets the second cover at the top and bottom edges to form respective seam portions (figures 2-3), as in claim 13, and where the first cover has at least one pair of top closing walls (32), wherein the second cover has top and bottom edges (42) that substantially meet a backside of the second cover, and wherein the at least one pair of top closing walls meets the second cover at the top and bottom edges to form respective seam portions (figures 2-3), as in claim 14.

Jaeb et al. further disclose the locking member engages the locking mate arrangement when the locking member is in the locked position, wherein the locking member is configured to be acted upon by an external key arrangement (24) to selectively position the locking member into one of the locked position and the unlocked position with respect to the locking mate arrangement (figures 15-17), and wherein the locking mate arrangement is formed as part of the first cover and the locking member is detachably coupled to the second cover (figures 1, 4 and 5), as in claim 15, wherein the locking member has at least one tab (54), and wherein the locking mate arrangement has at least one corresponding loop (64), as in claim 16, and the at least one

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tab is configured to engage the at least one corresponding loop when the locking member is in the locked position (figure 8), as in claim 17.

Jaeb et al. additionally disclose the locking member having at least one engagement structure (64) and the locking mate arrangement having at least one corresponding engagement structure (50 and 54), and wherein the engagement structure of the locking member is configured to engage the corresponding engagement structure of the locking mate arrangement (figure 8), as in claim 19, wherein the locking member has a stopping arrangement (figures 11 and 14) which selectively blocks the locking member from moving into the locked and unlocked positions, as in claim 20, wherein the at least one engagement structure of the locking member has at least one first magnetically attractable portion (72) configured to magnetically interact with a corresponding first magnet arrangement (90) of the external key arrangement, as in claim 21, as well as the stopping arrangement having at least one resilient locked position flange (72) biased into a locked state, wherein the container has a corresponding locked position tab (70), and wherein the locked position flange is configured to selectively engage the corresponding locked position tab to prevent the locking member from sliding into the unlocked position once in the locked position (figures 11 and 14), as in claim 22, and where the resilient locked position flange has at least one second magnetically attractable portion (72) configured to magnetically interact with a corresponding second magnet arrangement (90) of the external key arrangement, the magnetic interaction between the second magnetically attractable portion and the second magnet arrangement of the external key arrangement causing the resilient locked position flange to bend toward the external key arrangement (figure 18), as in claim 23.

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Jaeb et al. also disclose the first magnetically attractable portion is selected from a group consisting of a steel pin, a metallic pin, a metallic insert, a magnetic insert, and any combination thereof (paragraph 0039, lines 3-5), as in claim 24, and where the second magnetically attractable portion is selected from a group consisting of a steel pin, a metallic pin, a metallic insert, a magnetic insert, and any combination thereof (paragraph 0039, lines 3-5), as in claim 25, and where the stopping arrangement has at least one resilient unlocked position flange (72) biased into an unlocked state, wherein the container has a corresponding unlocked position tab (70), and wherein the unlocked position flange is configured to selectively engage the corresponding unlocked position tab to prevent the locking member from sliding into the locked position once in the unlocked position (figure 14), as in claim 26, as well as the external key arrangement interacts with the at least one corresponding engagement structure and the at least one stopping arrangement of the locking member to selectively move the locking member into the locked and unlocked positions (figures 11 and 14), as in claim 29, wherein the external key arrangement simultaneously interacts with the at least one corresponding engagement structure and the at least one stopping arrangement (figures 15-17), as in claim 30.

Jaeb et al. further disclose the locking member engages the locking mate arrangement when the locking member is in the locked position, and wherein the locking member is configured to be acted upon by an external magnetic key arrangement (24) to selectively position the locking member into one of the locked position and the unlocked position with respect to the locking mate arrangement, as in claim 31, as well as the locking member not being viewable from the outside of the container when the first and second covers are in the closed position (figures 2-3), as in claim 32, and where the container is sized as a standard library case

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(paragraph 0003), as in claim 33, wherein at least one of the first and second covers has a transparent portion (paragraph 0031, lines 7-11) configured to permit a user to view the asset in the container, as in claim 35, and where at least one of the first and second covers has a transparent jacket (paragraph 0031, lines 7-11) to display information materials related to the asset to a user, as in claim 36, and the container having at least one status window (68), wherein the locking member has an indicator (66), and wherein the indicator is configured to communicate to a user via the status window the unlocked or locked status of the container in accordance with a position of the locking member (figure 12), as in claim 38.

Jaeb et al. additionally disclose a method for securing an asset within a container, comprising providing a lockable container (10) having a first cover (12), a second cover (14) coupled to the first cover, a locking mate arrangement (50 and 54) operatively coupled to at least one of the first and second covers, and a locking member (18), wherein the first and second covers are in a closed position which encloses the asset (figure 3), and wherein the locking member is in an unlocked position in which the first and second covers can move to an open position (figures 1 and 2) and in which the locking member is internal to the container (figures 2 and 3) and an actuation member on the distal end of the locking member (figure 10) extends beyond the container when in the unlocked position, and moving the locking member from the unlocked position to a locked position to lock the first and second covers in the closed position (22), as in claim 39. However, Jaeb et al. do not disclose the entirety of the locking member being internal to the container in the unlocked position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the actuation member

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from the distal end of the locking member, and actuate the locking member by means of the unlocking pin of the key to move the locking member into both the locked and unlocked positions, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Jaeb et al. also disclose locking member from the unlocked position to the locked position comprises engaging the locking mate arrangement with the locking member (figures 6-8), as in claim 40, as well as the moving the locking member comprises acting upon the locking member with an external key arrangement (24) to move the locking member into the locked position with respect to the locking mate arrangement (figures 15-17), and engaging the locking mate arrangement with the locking member (figures 6-8), as in claim 41.

Jaeb et al. further disclose the locking mate arrangement is formed as part of the first and second covers (figure 1), and wherein the locking member is detachably coupled to the second cover (figures 2-5), as in claim 42, wherein the locking mate arrangement has at least one tab (54) formed in the first cover and at least one corresponding tab (50) formed in the second cover, as in claim 43, as well as the at least one tab formed in the first cover and the at least one corresponding tab formed in the second cover are in an adjacent relationship when the first and second covers are in the closed position (figures 6-7), as in claim 44, and where at least a portion of the locking member has an I-beam construction (figures 4 and 5) with a recess formed therein, as in claim 45, as well as the at least one tab formed in the first cover and the at least one corresponding tab formed in the second cover are located in the recess and prevented from separating when the locking member is in the locked position (figure 8), as in claim 46.

Jaeb et al. additionally disclose the first cover having at least one pair of top closing walls (32) and the second cover has at least one pair of bottom closing walls (38), and wherein the top and bottom pairs of closing walls are disposed so that each of the respective top and bottom closing walls sits behind the other of the respective top and bottom closing walls when the first cover is closed upon the second cover (figures 2 and 3), thereby forming a double wall so that each of the respective top and bottom closing walls substantially overlaps a major portion of the height of the other of the respective top and bottom closing walls, as in claim 47, wherein each of the at least one pair of top closing walls and each of the at least one pair of bottom closing walls extends the entire width of the respective first and second covers (figure 1), as in claim 48, and each of the at least one pair of top closing walls and each of the at least one pair of bottom closing walls extends substantially the entire width of the respective first and second covers (figure 1), as in claim 49.

Jaeb et al. also disclose the first cover having at least one pair of top closing walls (32), wherein the second cover has top and bottom edges (42) that meet a backside of the second cover, and wherein the at least one pair of top closing walls meets the second cover at the top and bottom edges to form respective seam portions (figures 2-3), as in claim 50, as well as the first cover having at least one pair of top closing walls (32), wherein the second cover having top and bottom edges (42) that substantially meet a backside of the second cover, and wherein the at least one pair of top closing walls meeting the second cover at the top and bottom edges to form respective seam portions (figures 2-3), as in claim 51.

Jaeb et al. also disclose the locking mate arrangement is formed as part of the first cover (figure 1) and the locking member is detachably coupled to the second cover (figures 2-5), and

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wherein the moving the locking member comprises acting upon the locking member with an external key arrangement (24) to move the locking member into the locked position with respect to the locking mate arrangement, and engaging the locking mate arrangement with the locking member (figures 15-17), as in claim 52, wherein the locking member has at least one tab (54), and wherein the locking mate arrangement has at least one corresponding loop (64), as in claim 53, as well as moving the locking member from the unlocked position to the locked position further comprises engaging the at least one loop of the locking member with the corresponding at least one tab of the locking mate arrangement (figure 8), as in claim 54.

Jaeb et al. further disclose the locking member has at least one engagement structure (64) and the locking mate arrangement has at least one corresponding engagement structure (50 and 54), and wherein the moving the locking member from the unlocked position to the locked position further comprises engaging the corresponding engagement structure of the locking mate arrangement with the engagement structure of the locking member (figure 8), as in claim 55, wherein the locking member has a stopping arrangement (figures 11 and 14) which selectively blocks the locking member from moving into the locked and unlocked positions, as in claim 56, as well as the at least one engagement structure of the locking member has at least one first magnetically attractable portion (72) configured to magnetically interact with a corresponding first magnet arrangement (90) of the external key arrangement, as in claim 57, and where the stopping arrangement has at least one resilient locked position flange (72) biased into a locked state, wherein the container has a corresponding locked position tab (70), the method further comprising engaging the locked position tab with the corresponding locked position flange to prevent the locking member from sliding into the unlocked position once in the locked position

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(figures 11 and 14), as in claim 58, as well as the resilient locked position flange has at least one second magnetically attractable portion (72) configured to magnetically interact with a corresponding second magnet arrangement (90) of the external key arrangement (figure 18), the method further comprising causing the resilient locked position flange to bend toward the external key arrangement due to the magnetic interaction between the second magnetically attractable portion and the second magnet arrangement of the external key arrangement (figures 15-18), as in claim 59.

Jaeb et al. additionally disclose moving the locking member comprises engaging the at least one corresponding engagement structure and the at least one stopping arrangement with the external key arrangement to move the locking member into the locked position (figures 15-17), as in claim 60, wherein the moving the locking member further comprises simultaneously engaging the at least one corresponding engagement structure and the at least one stopping arrangement with the external key arrangement (figures 15-17), as in claim 61.

Jaeb et al. also disclose moving the locking member comprises acting upon the locking member with an external magnetic key arrangement (24) to position the locking member into the locked position with respect to the locking mate arrangement (figure 11 and 14), and engaging the locking mate arrangement with the locking member when the locking member is in the locked position (figure 8), as in claim 62, and where the locking member is not viewable from the outside of the container when the first and second covers are in the closed position (figures 2-3), as in claim 63, as well as the container having at least one status window (68), wherein the locking member has an indicator (66), the method further communicating to a user with the

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indicator via the status window the unlocked or locked status of the container in accordance with the position of the locking member (figure 12), as in claim 65.

Jaeb et al. further disclose a method for accessing an asset from within a container, comprising providing a lockable container (10) having a first cover (12), a second cover (14) coupled to the first cover, a locking mate arrangement (50 and 54) operatively coupled to at least one of the first and second covers, and a locking member (18), wherein the first and second covers are in a closed position which encloses the asset (figure 3), and wherein the locking member is in a locked position which locks the first and second covers in the closed position (figure 8), and moving the locking member from the locked position to an unlocked position in which the first and second covers can move to an open position (figures 15-17), wherein the locking member is internal to the container in the unlocked position (figure 2), where an actuation member on the distal end of the locking member (figure 10) extends beyond the container when in the unlocked position as in claim 66. However, Jaeb et al. do not disclose the entirety of the locking member being internal to the container in the unlocked position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the actuation member from the distal end of the locking member, and actuate the locking member by means of the unlocking pin of the key to move the locking member into both the locked and unlocked positions, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Jaeb et al. additionally disclose the locking member engages the locking mate arrangement when the locking member is in the locked position (figure 8), as in claim 67, and the locking member engaging the locking mate arrangement when the locking member is in the locked position (figure 8), and wherein the moving the locking member comprises acting upon the locking member with an external key arrangement (24) to position the locking member into the unlocked position with respect to the locking mate arrangement (figure 15-17), as in claim 68.

Jaeb et al. also disclose the locking mate arrangement is formed as part of the first and second covers (figure 1), and wherein the locking member is detachably coupled to the second cover (figures 2-5), as in claim 69, wherein the locking mate arrangement has at least one tab (54) formed in the first cover and at least one corresponding tab (50) formed in the second cover, as in claim 70, and where the at least one tab formed in the first cover and the at least one corresponding tab formed in the second cover are in an adjacent relationship when the first and second covers are in the closed position (figures 6-7), as in claim 71, as well as at least a portion of the locking member having an I-beam construction (figures 4 and 5) with a recess formed therein, as in claim 72, wherein the at least one tab formed in the first cover and the at least one corresponding tab formed in the second cover are located in the recess and prevented from separating when the locking member is in the locked position (figure 6-8), as in claim 73.

Jaeb et al. further disclose the first cover has at least one pair of top closing walls (32) and the second cover has at least one pair of bottom closing walls (38), and wherein the top and bottom pairs of closing walls are disposed so that each of the respective top and bottom closing walls sits behind the other of the respective top and bottom closing walls when the first cover is

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closed upon the second cover (figures 2-3), thereby forming a double wall so that each of the respective top and bottom closing walls substantially overlaps a major portion of the height of the other of the respective top and bottom closing walls, as in claim 74, wherein each of the at least one pair of top closing walls and each of the at least one pair of bottom closing walls extends the entire width of the respective first and second covers (figure 1), as in claim 75, as well as each of the at least one pair of top closing walls and each of the at least one pair of bottom closing walls extends substantially the entire width of the respective first and second covers (figure 1), as in claim 76.

Jaeb et al. additionally disclose the first cover has at least one pair of top closing walls (32), wherein the second cover has top and bottom edges (42) that meet a backside of the second cover, and wherein at least one pair of top closing walls meets the second cover at the top and bottom edges to form respective seam portions (figures 1-3), as in claim 77, as well as the first cover has at least one pair of top closing walls (32), wherein the second cover has top and bottom edges (42) that substantially meet a backside of the second cover, wherein at least one pair of top closing walls meets the second cover at the top and bottom edges to form respective seam portions (figures 1-2), as in claim 78.

Jaeb et al. also disclose the locking mate arrangement is formed as part of the first cover and the locking member is detachably coupled to the second cover (figures 1-5), wherein the locking member engages the locking mate arrangement when the locking member is in the locked position (figure 8), and wherein the moving the locking member comprises acting upon the locking member with an external key arrangement (24) to position the locking member into the unlocked position with respect to the locking mate arrangement (figures 15-17), as in claim

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79, wherein the locking member has at least one tab (54), and wherein the locking mate arrangement has at least one corresponding loop (64), as in claim 80, as well as the at least one tab is configured to engage the at least one corresponding loop when the locking member is in the locked position (figure 8), as in claim 81.

Jaeb et al. further disclose the locking member having at least one engagement structure (64) and the locking mate arrangement has at least one corresponding engagement structure (50 and 54), and wherein the engagement structure of the locking member is configured to engage the corresponding engagement structure of the locking mate arrangement (figure 8), as in claim 82, and where the locking member has a stopping arrangement (figures 11 and 14) which selectively blocks the locking member from moving into the locked and unlocked positions, as in claim 83, and the at least one engagement structure of the locking member has at least one first magnetically attractable portion (72) configured to magnetically interact with a corresponding first magnet arrangement (90) of the external key arrangement, as in claim 84, and where the stopping arrangement has at least one resilient locked position flange (72) biased into a locked state, wherein the container has a corresponding locked position tab (70), and wherein the locked position flange is configured to selectively engage the corresponding locked position tab to prevent the locking member from sliding into the unlocked position when in the locked position, as in claim 85.

Jaeb et al. additionally disclose the resilient locked position flange has at least one second magnetically attractable portion (72) configured to magnetically interact with a corresponding second magnet arrangement (90) of the external key arrangement, the magnetic interaction between the second magnetically attractable portion and the second magnet arrangement of the

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external key arrangement causing the resilient locked position flange to bend toward the external key arrangement (figure 18), as in claim 86, as well as the stopping arrangement has at least one resilient unlocked position flange (72) biased into an unlocked state, wherein the container has a corresponding unlocked position tab (70), the method further engaging the corresponding unlocked position tab with the unlocked position flange to prevent the locking member from sliding into the locked position once in the unlocked position (figures 11 and 14), as in claim 87.

Jaeb et al. also disclose moving the locking member further comprises engaging the at least one corresponding engagement structure and the at least one stopping arrangement of the locking member with the external key arrangement to move the locking member into the unlocked position (figures 11 and 14), as in claim 90, wherein the moving the locking member further comprises simultaneously engaging the at least one corresponding engagement structure and the at least one stopping arrangement of the locking member with the external key arrangement (figures 15-17), as in claim 91.

Jaeb et al. further disclose the locking member engages the locking mate arrangement when the locking member is in the locked position (figure 8), and wherein the moving the locking member comprises acting upon locking member with an external magnetic key arrangement (24) to position the locking member into the unlocked position with respect to the locking mate arrangement (figures 15-17), as in claim 92, as well as the locking member not being viewable from the outside of the container when the first and second covers are in the closed position (figures 2-3), as in claim 93, and the container having at least one status window (68), wherein the locking member has an indicator (66), the method further communicating to a

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user with the indicator via the status window the unlocked or locked status of the container in accordance with the position of the locking member (figure 9), as in claim 95.

Jaeb et al. additionally disclose a lockable container (10) for securing an asset, comprising a base portion (12) having a locked position receptacle (70), a cover (14) pivotally coupled (16) to the base portion to enclose the asset in the container, a locking mate arrangement (50 and 54) coupled to at least one of the cover and the base portion, the locking mate-arrangement having at least one tab (54) portion, and a locking member (18) slidably coupled to at least one of the cover and the base portion (figures 3-5), the locking member being arranged within the container, having an actuation member on the distal end of the locking member (figure 10) extends beyond the container when in the unlocked position, and configured to detachably couple to the locking mate arrangement to secure the cover to the base portion (figures 2-3), thereby retaining the asset within the container, the locking member further comprising at least one engagement structure (64) configured to engage the at least one tab portion, at least one first magnetically attractable portion (72) configured to magnetically interact with a corresponding first magnet arrangement (90) of an external key arrangement (24), at least one resilient locked position flange (72) biased into a locking state, the locked position flange being configured to selectively engage the locked position receptacle to prevent the locking member from sliding into an unlocked position once in a locked position (figures 11 and 14), and wherein the locking member is configured to be acted upon by the external key arrangement to selectively position the locking member into one of the locked position and the unlocked position with respect to the locking mate arrangement (figures 15-17), as in claim 96. However, Jaeb et al. do not disclose the entirety of

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the locking member being internal to the container in the unlocked position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the actuation member from the distal end of the locking member, and actuate the locking member by means of the unlocking pin of the key to move the locking member into both the locked and unlocked positions, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Jaeb et al. also disclose a system for securing and gaining access to an asset, comprising a lockable container (10) for securing an asset having a first cover (12), a second cover (14) pivotally coupled (16) to the first cover to enclose the asset within the container, a locking mate arrangement (50 and 54) coupled to at least one of the first and second covers, and a locking member (18) slidably coupled to at least one of the first and second covers, wherein the locking member is configured to detachably couple to the locking mate arrangement to secure the first cover to second cover (figures 6-8), thereby retaining the asset item within the container, and a key arrangement (24) for at least one of locking and unlocking the container, the key arrangement having a receptacle arrangement (figure 15) configured to receive the container, wherein the receptacle arrangement has at least one magnet arrangement (90) configured to at least one of lock and unlock the container, wherein the locking member is configured to be acted upon by the external key arrangement to selectively position the locking member into one of a locked position and an unlocked position with respect to the locking mate arrangement (figures 15-17), and wherein the locking member is internal to the container in the unlocked position

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(figures 2-3), as well as an actuation member on the distal end of the locking member (figure 10) extends beyond the container when in the unlocked position, as in claim 107. However, Jaeb et al. do not disclose the entirety of the locking member being internal to the container in the unlocked position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the actuation member from the distal end of the locking member, and actuate the locking member by means of the unlocking pin of the key to move the locking member into both the locked and unlocked positions, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Jaeb et al. further disclose a method for securing an asset within a container (10), comprising providing a lockable container (10) having a first cover (12), a second cover (14) pivotally coupled (16) to the first cover to enclose the asset within the container, a locking mate arrangement (50 and 54) coupled to at least one of the first and second covers, and a locking member (18) slidably coupled to at least one of the first and second covers, wherein the locking member is in an unlocked position, and wherein the locking member is internal to the container when the locking member is in the unlocked position (figures 2-3) and having an actuation member on the distal end of the locking member (figure 10) extends beyond the container when in the unlocked position, providing a key arrangement (24) for unlocking the container, the key arrangement having a receptacle arrangement (figure 15), wherein the receptacle arrangement has at least one magnet arrangement (90), positioning the container within the receptacle arrangement (figure 16), acting upon the container with the at least one magnet arrangement to

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move the locking member from the unlocked position into a locked position with respect to the locking mate arrangement, such that the locking member engages the locking mate arrangement to secure the first cover to the second cover (figure 17), as in claim 108.

However, Jaeb et al. do not disclose the entirety of the locking member being internal to the container in the unlocked position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the actuation member from the distal end of the locking member, and actuate the locking member by means of the unlocking pin of the key to move the locking member into both the locked and unlocked positions, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Jaeb et al. additionally disclose a method for providing access to an asset from within a container (10), comprising providing a lockable container (10) having a first cover (12), a second cover (14) pivotally coupled (16) to the first cover to enclose the asset within the container, a locking mate arrangement (50 and 54) coupled to at least one of the first and second covers, and a locking member (18) slidably coupled to at least one of the first and second covers, wherein the locking member is internal to the container in an unlocked position (figures 2 and 3) and having an actuation member on the distal end of the locking member (figure 10) extends beyond the container when in the unlocked position, and wherein the locking member engages the locking mate arrangement to secure the first cover to the second cover in a locked position (figure 8), providing a key arrangement (24) for unlocking the container, the key arrangement having a receptacle arrangement (figure 15), wherein the receptacle arrangement has at least one magnet

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arrangement (90), positioning the container within the receptacle arrangement (figure 16), acting upon the container with the at least one magnet arrangement to move the locking member from the locked position into the unlocked position with respect to the locking mate arrangement (figure 17), as in claim 109. However, Jaeb et al. do not disclose the entirety of the locking member being internal to the container in the unlocked position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the actuation member from the distal end of the locking member, and actuate the locking member by means of the unlocking pin of the key to move the locking member into both the locked and unlocked positions, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Jaeb et al. also disclose a lockable container (10) for securing an asset, comprising a first cover (12), a second cover (14) coupled to the first cover, the first and second covers configured to move between an open position which allows access to the asset and a closed position which encloses the asset (figures 1-3), at least one tab (54) portion coupled to the first cover, at least one corresponding tab (50) portion coupled to the second cover, and a locking member (18) operatively coupled to at least one of the first and second covers, wherein the locking member has a trap portion (64) and a release portion (figures 4 and 5), wherein the locking member is configured to move between an unlocked position in which the first and second covers can move to the open position and a locked position which locks the container in the closed position (22), and wherein the locking member is internal to the container in the unlocked position (figures 2-

3) and having an actuation member on the distal end of the locking member (figure 10) extends beyond the container when in the unlocked position, as in claim 110. However, Jaeb et al. do not disclose the entirety of the locking member being internal to the container in the unlocked position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the actuation member from the distal end of the locking member, and actuate the locking member by means of the unlocking pin of the key to move the locking member into both the locked and unlocked positions, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Jaeb et al. further disclose the locking member being configured such that, in the locked position, the at least one tab portion and the at least one corresponding tab portion are located in the trap portion and prevented from separating (figure 8), as in claim 111, wherein the at least one tab portion and the at least one corresponding tab portion face each other in an adjacent relationship when located in the trap portion (figure 8), as in claim 112, as well as the locking member being configured such that, in the unlocked position, the at least one tab portion and the at least one corresponding tab portion are located in the release portion and are allowed to separate (figures 6 and 7), as in claim 113.

Jaeb et al. additionally disclose the top cover having at least two tab portions, wherein the bottom cover has at least two corresponding tab portions (figure 1), and wherein the locking member has at least one pair of trap portions located on opposite sides of the locking member (figures 4-5), as in claim 114, wherein the container is configured such that, in the locked position, one of the at least two tab portions and one of the at least two corresponding tab

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portions are located in one of the at least one pair of trap portions in an adjacent relationship (figure 6), and the other of the at least two tab portions and the other of the at least two corresponding tab portions are located in the other of the at least one pair of trap portions in an adjacent relationship (figure 7), wherein the at least two tab portions are prevented from separating from the at least two corresponding tab portions (figure 8), as in claim 115, and further comprising an electronic security tag (paragraph 0005), wherein the electronic security tag is situated within the container and is inaccessible when the locking member is in the locked position, as in claim 116.

Jaeb et al. also disclose the first cover having at least one pair of top closing walls (32) and the second cover includes at least one pair of bottom closing walls (38), and wherein the top and bottom pairs of closing walls are disposed so that when the first cover is closed upon the second cover (figures 1-3), each of the respective top and bottom closing walls sits behind the other of the respective top and bottom closing walls, thereby forming a double wall, and each of the respective top and bottom closing walls substantially overlaps a major portion of the height of the other of the respective top and bottom closing walls (figure 3), as in claim 117, wherein each of the at least one pair of top closing walls and each of the at least one pair of bottom closing walls extends the entire width of the respective first and second covers (figure 1), as in claim 118, as well as each of the at least one pair of top closing walls and each of the at least one pair of the bottom closing walls extends for substantially the entire width of the respective first and second covers (figure 1), as in claim 119.

Jaeb et al. further disclose the first cover having at least one pair of top closing walls (32), wherein the second cover has top and bottom edges (42) that meet a backside of the second

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cover, and wherein the at least one pair of top closing walls meets the second cover at the top and bottom edges to form respective seam portions (figures 2-3), as in claim 120, as well as the first cover has at least one pair of top closing walls (32), wherein the second cover has top and bottom edges (42) that substantially meet a backside of the second cover, and wherein the at least one pair of top closing walls meets the second cover at the top and bottom edges to form respective seam portions (figures 2 and 3), as in claim 121.

Jaeb et al. additionally disclose a lockable container (10) for securing an asset therein, comprising a receptacle, wherein the receptacle has an open configuration (figure 1) which allows access to the asset and a closed configuration (figure 3) which encloses the asset, a locking mate arrangement (50 and 54) operatively coupled to the receptacle, and a locking member (18), wherein the locking member is configured to move between an unlocked position in which the receptacle is in the open configuration and a locked position which locks the receptacle in the closed configuration (22), and wherein the locking member is internal to the container in the unlocked position (figures 2-3), as well as an actuation member on the distal end of the locking member (figure 10) extends beyond the container when in the unlocked position, as in claim 122. However, Jaeb et al. do not disclose the entirety of the locking member being internal to the container in the unlocked position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to omit the actuation member from the distal end of the locking member, and actuate the locking member by means of the unlocking pin of the key to move the locking member into both the locked and unlocked positions, since it has been held that omission of an element and its function in a combination where the remaining

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elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Claims 18 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaeb et al., as applied above.

Jaeb et al. disclose the invention substantially as claimed. Jaeb et al. disclose the locking member forms a single molded structure (figures 4 and 5), where the locking member is molded from a plastic material (paragraph 0005), as in claims 18 and 34. However, Jaeb et al. does not disclose the exact plastic material from which the locking member is molded. It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose a suitable plastic that would be capable of performing the suitable function desired for the locking member, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Claims 27-28 and 88-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaeb et al., as applied above.

Jaeb et al. discloses the claimed invention except for the resilient unlocked position flange of the stopping arrangement having a third magnetically attractable portion, as in claims 27-28 and 88-89. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a third magnetically attractable portion to interact with a corresponding magnet arrangement of the external key arrangement, since it has been held that

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mere duplication of the essential working parts of a device involves only routine skill in the art.

St. Regis Paper Co. V. Bemis Co., 193 USPQ 8.

Claims 37, 64, and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaeb et al., as applied above, in view of U.S. Patent Number 5,988,376 to Lax.

Jaeb et al. discloses the invention substantially as claimed. However, Jaeb et al. does not disclose that either the first or second covers have a securing mechanism to retain an asset within the current container, as in claims 37, 64, and 94. Lax teaches of a container (200) used to securely retain an asset therein, by means of a securing mechanism (213) attached to a first or second cover of the container in the same field of endeavor for the purpose of releasably engaging a center aperture of a disk (column 14, lines 21-23). It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a securing mechanism, as taught by Lax, within a cover of Jaeb et al. in order to releasably engage a center aperture of a disk.

Response to Arguments

Applicant's arguments, see pages 45-48 of the remarks, filed September 23, 2005, with respect to the rejection(s) of claim(s) 1-17, 19-26, 29-33, 35-36, 38-63, 65-87, 90-93, 95-96, and 107-130 under 35 U.S.C. 102 (b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of different interpretation of the previously applied reference.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Boswell whose telephone number is (571) 272-7054. The examiner can normally be reached on 9:00 - 4:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CJB *CB*
November 30, 2005

Brian E. Glessner
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